

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the present application are respectfully requested and in view of the amendments to the specification and claims, the accompanying documents, and remarks presented herewith, which place the application into condition for allowance.

Status of the Claims and Formal Matters

Claims 46-60 are currently pending in this application. Claims 51, 52, 54 -57, and 60 were withdrawn from consideration as allegedly being directed to a non-elected invention. By this paper, claims 46, 47, 49, 53, 58, and 59 have been amended, without prejudice, and solely to expedite prosecution pursuant to the U.S. Patent & Trademark Office Business Goals (65 Fed. Reg. 54604 (September 8, 2000)). No new matter has been introduced by these amendments. Support for the amendments can be found throughout the specification as originally filed.

The Office Action at page 2 objected to the Information Disclosure Statement filed on September 2, 2008 for allegedly failing to include copies of the cited foreign references (WO03/070735 and WO02/066012). Applicant submits herewith copies of the two references, labeled as B1 and B2 respectively.

The Office Action at pages 2-3 objected to Figure 3 for allegedly being difficult to interpret. Applicant submits herewith a new corrected drawing for Figure 3 which is believed to be in compliance with 37 C.F.R. §1.121(d) and a Petition to Accept Color Photographs as Formal Drawings with the required fee and requests that this objection be withdrawn.

The specification was objected to for allegedly failing to indicate which of the two panels relate to a phase contrast micrograph and fluorescence-microscopic image for cell localization. Figure 3 has been corrected to indicate the left panel as "A" and the right panel as "B". The specification has also been amended to indicate that panel "A" refers to the fluorescence-microscopic image and panel "B" refers to the phase-contrast micrograph for cell localization. This objection should be withdrawn.

Rejections under 35 U.S.C. §112, 2nd paragraph

Claims 53 and 58 were rejected under 35 U.S.C. §112, 2nd paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, claim 53 was rejected for allegedly reciting several ratios without indicating the basis for them. Claim 58 was rejected for reciting “said mixtures”, which allegedly lacks proper antecedent basis.

By this paper, claims 53 and 58 have been amended, without prejudice. In view of these amendments, the §112, 2nd paragraph rejections should be withdrawn.

Rejections under 35 U.S.C. §112, 4th paragraph

Claim 49 was rejected for allegedly not providing a further limitation of the subject matter claimed. According to the Office Action, claim 46 requires an oligonucleotide, while claim 49 requires it to be in single strands, double strands, or in complex folding. The Office Action argues that the claim is not further limiting on the claim from which it depends. Applicant respectfully disagrees, but in the interest of expediting prosecution, has amended claim 49 to delete the complex folding recitation. Accordingly, this rejection should be withdrawn.

Rejections under 35 U.S.C. §102(e)

Claims 46 and 48-50 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 20060159737 (herein “Panzner”), or, in the alternative, as not being patentable under 35 U.S.C. §103(a) to the same reference, as further evidenced by <http://www.rockefeller.edu/labheads/tuschl.sirna.html>. According to the Office Action, Panzner has a common inventor with the instant application, and based upon the earlier effective U.S. filing date of the references, it constitutes prior art under 35 U.S.C. §102(e). The Office Action further states that this rejection might be overcome either by a showing under 37 C.F.R. §1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another”, or by an appropriate showing under 37 C.F.R. §1.131.

Applicant submits herewith a Declaration of Gerold Endert under 37 C.F.R. §1.132, which attests that the invention is not “by another” within the meaning of 35 U.S.C. §102(e).

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §102(e) rejection over Panzner.

Rejections under 35 U.S.C. §103(a)

Claims 46-60 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Panzner as further evidenced by <http://www.rockefeller.edu/labheads/tuschl.sirna.html> (herein “Rockefeller”). According to the Office Action, it would allegedly have been obvious to make the composition of the instant claims, and the skilled artisan would have done so to treat colitis because both compositions had already been shown to be successful in delivery of nucleic acids. As stated by the Office Action at page 5, Panzner is §102(e) art. In view of the Declaration of Gerold Endert submitted herewith, the present invention is not “by another”. Accordingly, Applicant hereby avails themselves of the provisions of §103(c) to remove Panzner as available art.

Under the provisions of §103(c)(1), subject-matter that was developed by another person shall not preclude patentability where the subject-matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Cooperative Research and Technology Enhancement Act of 2004, 118 Stat. 3596. Applicant respectfully submits the subject-matter disclosed in Panzner and the instant invention were, at the time the present application was filed, subject to an obligation of assignment to the same entity, Novosom AG. The assignee of the Panzner application, filed on November 4, 2005, is “Novosom AG” as evidenced by Reel and Frame No. 017720/0570 (and a subsequent corrective assignment at Reel and Frame No. 019771/0919). The present application is a U.S. national phase application derived from PCT/DE2005/000589 (published as WO2005/094783), filed on March 29, 2005 and has a 35 U.S.C. §371 date of September 2, 2008. The PCT application lists Novosom AG as the Applicant. In addition, the present application was assigned to Novosom AG and recorded at Reel and Frame No.021469/0567 on September 2, 2008. Therefore, at the time the instant application was filed, the Panzner reference and the claimed invention were commonly owned by Novosom AG as indicated by the assignment recordation at the USPTO. Consequently, Panzner is unavailable as prior art under §102 (or §103). Applicant respectfully requests reconsideration and withdrawal of the present rejections under §103(a) over Panzner as evidenced by Rockefeller.

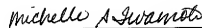
CONCLUSION

Favorable action on the merits is respectfully requested. If any discussion regarding this Response is desired, the Examiner is respectfully urged to contact the undersigned at the number given below, and is assured of full cooperation in progressing the application to allowance.

Applicant believes no fees are due with the filing of this Response, however if any fees are required or if any funds are due, the USPTO is authorized to charge or credit Deposit Account Number **50-0311**, Customer Number: **35437**, Reference Number: **29627-221N01US**.

Respectfully submitted,

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